



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,096	07/26/2000	Robert M Umek	067456-5030-US	8157

67374 7590 05/01/2008  
MORGAN, LEWIS & BOCKIUS, LLP  
ONE MARKET SPEAR STREET TOWER  
SAN FRANCISCO, CA 94105

EXAMINER
----------

CALAMITA, HEATHER

ART UNIT	PAPER NUMBER
----------	--------------

1637

MAIL DATE	DELIVERY MODE
-----------	---------------

05/01/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 09/626,096	<b>Applicant(s)</b> UMEK ET AL.	
	<b>Examiner</b> HEATHER G. CALAMITA	<b>Art Unit</b> 1637	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 07 April 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 60-69.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

/GARY BENZION/  
 Supervisory Patent Examiner, Art Unit 1637

Heather G. Calamita, Ph.D.  
 Examiner  
 Art Unit: 1637

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' arguments filed April 7, 2008, have been fully considered but they are not persuasive. Applicants argue the Examiner's combination of teachings does not arrive at the presently claimed invention. This is not the standard under 35 USC 103 (a). A proper rejection under 103 (a) must meet the following criteria: 1. Determining the scope and contents of the prior art. 2. Ascertaining the differences between the prior art and the claims at issue. 3. Resolving the level of ordinary skill in the pertinent art. 4. Considering objective evidence present in the application indicating obviousness or nonobviousness. These criteria were met in the rejection made over claims 60-69 in the office action mailed February 7, 2008. It is unclear from Applicants' argument what was not disclosed. The rejection made indicated where in each of the references each limitation could be found. Additionally, it appears if Applicants are arguing the references separately. As outlined in both the rejection and response to arguments in the office action mailed February 7, 2008, the references cannot be addressed individually. Applicants argue there is no motivation or reason to combine the teachings. This argument is not persuasive because while the method of Shuber is a two step method that alone does not lead a skilled artisan away from using multiple and different labels. As outlined in the rejection in the office action mailed February 7, 2008, Kayyem states that no electron transfer occurs unless nucleotide base pairing exists in the double stranded sequence between the electron donor and acceptor. This property is particularly advantageous for the detection of nucleotide mutations using the multiple probe methods as described by Shuber in allele specific oligonucleotide hybridization. Therefore a skilled artisan would want to apply the ETM labels as taught by Kayyem with the multiple probes taught by Shuber to have a more efficient and accurate detection method. Applicants argue no part of a reference has been cited that teaches a second label probe comprising a second ETM with a second redox potential and that the teaching of Shuber of "multiple oligonucleotide probes with labels" is not a teaching of a second label probe comprising a second ETM with a second redox potential. This argument is not persuasive because Shuber teaches multiple labels which can be used for detection. Additionally Kayyem teaches a first ETM label on a first oligonucleotide and a second ETM label on a second oligonucleotide where upon hybridization an electron is transferred from one ETM on the first oligonucleotide to the second ETM on the second oligonucleotide (see p. 52 lines 6-24).